



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/775,207
Applicant : HUBBARD, MICHAEL
Filed : FEBRUARY 11, 2004
Title : FABRIC BACKED COVERING MEMBRANE WITH PRE-APPLIED
ADHESIVE

Art Unit : 1773
Examiner : ZIRKER, DANIEL R.

Atty Docket No. : OMNO-0003-UT1

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In conjunction with the Notice of Appeal concurrently filed for the above application involving Claims 1-20 on appeal, Applicant respectfully request a Pre-Appeal Brief Review further to the Official Gazette Notice of July 12, 2005 and the January 10, 2006 Extension thereof which authorizes Pre-Appeal Brief Conferences.

I. Basis for Request for Review.

This request is necessitated by: (1) the failure of the Examiner to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant's December 29, 2005 Amendment (Applicant's December Amendment); (2) the failure of the Examiner to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant's May 12, 2006 Amendment after Final (Applicant's Amendment After Final); (3) the failure of the Final Action to provide an explanation as to why various claims terms do not meet the requirements of 35 U.S.C. § 112; and (4) the failure of the Final Action to fully address the deficiencies of the Non-Final Office Action that were identified by Applicant and discussed in detail in Applicant's December Amendment.

A. Failure to Comply with 37 CFR § 1.104(d)(2) in Providing Affidavit/Declaration in Response to Request in Applicant's December Amendment.

In the September 30, 2005 Non-Final Office Action (Non-Final Office Action), the Examiner rejected Claims 1-20, despite failing to identify where various claimed features were taught or suggested by the cited references and failing to provide proper motivation for combining the references. In responding to the Non-Final Office Action, (see Applicant's December Amendment, Section F, pp. 20-22), Applicant properly requested the Examiner to supply an Affidavit/Declaration under 37 CFR § 1.104(d)(2) to provide the factual bases upon which the Examiner relied in rejecting Claims 1-20 over the combination of U.S. Patent No. 5,456,785 to Venable (Venable '785) or U.S. Patent No. 4,996,812 to Venable (Venable '812) in view of International Patent No. WO98/56866 (WO '866). To date, the Examiner has failed to provide the Applicant with the requested Affidavit/Declaration.

Also, in the May 24, 2006 Advisory Action (Advisory Action), the Examiner states that "after carefully reviewing the two earlier prior art rejection paragraphs of record based on the Venable references he can only state that he has simply no idea of what personal knowledge applicant is referring to." However, Applicant's December Amendment specifically discussed in Sections E(1)(a)(ii) and E(1)(b)(ii) why the Examiner's alleged grounds for rejecting Claims 1-20 over Venable '785 was based on facts within the personal knowledge of the Examiner (see Applicant's December Amendment, Sections E(1)(a)(ii), E(1)(b)(ii) and (F)). Applicant's December Amendment also specifically discussed in Section E(4) why the Examiner's alleged motivation for combining WO '866 with Venable '785 and/or Venable '812 was based on facts within the personal knowledge of the Examiner (see Applicant's December Amendment, Sections E(4) and (F)). Therefore, the Examiner's comment in the Advisory Action that he has "no idea of what personal knowledge applicant is referring to" appears to indicate that the Examiner has never read Sections E and F of Applicant's Amendment.

Because the Examiner has failed to provide Applicant with a properly requested Affidavit/Declaration, under 37 CFR § 1.104(d)(2), and, possibly, has failed to even read the Applicant's request for an Affidavit/Declaration under 37 CFR § 1.104(d)(2) in Applicant's December Amendment, the rejection of Claims 1-20 over the combination of combination of Venable '785 or Venable '812 in view of WO '866 is *prima facie* improper and should be withdrawn.

B. Failure to Comply with 37 CFR § 1.104(d)(2) in Providing Affidavit/Declaration in Response to Request in Applicant's After Final Amendment.

In the Final Action, the Examiner rejected Claims 1-20, despite failing to identify where various claimed features were taught or suggested by the cited references. In responding to the Final

Action, (see Applicant's After Final Amendment, Section I, pp. 20-22), Applicant properly requested the Examiner to supply an affidavit/declaration under 37 CFR § 1.104(d)(2) to provide the factual bases upon which the Examiner relied in rejecting Claims 1-20 over the combination of Venable '785 or '812 in view of WO '866. To date, the Examiner has failed to provide the Applicant with the requested affidavit/declaration. The Examiner's comments in the Advisory Action fail to address Applicant's comments in Section I of Applicant's After Final Amendment.

Because the Examiner has failed to provide Applicant with a properly requested Affidavit/Declaration, under 37 CFR § 1.104(d)(2) in Applicant's December Amendment, the rejection of Claims 1-20 over the combination of Venable '785 or '812 in view of WO '866 is *prima facie* improper and should be withdrawn.

C. **Failure to provide an explanation as to why various claims terms do not meet the requirements of 35 U.S.C. § 112.**

As discussed in Section B of Applicant's After Final Amendment, and as set forth by the Manual of Patent Examining Procedure (MPEP) in § 2171, there are two separate requirements of 35 U.S.C. § 112, second paragraph: (A) the claims must set forth the subject matter that applicant regards as his invention; and (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The Final Action provides no explanation as to why the term "covering product" fails to comply with the requirements of 35 U.S.C. § 112. Similarly, the Final Action provides no explanation as to why the phrases "a membrane comprising a thermoplastic" and "said fabric layer being comprised of a fabric material" in Claims 1 and 11 fail to comply with the requirements of 35 U.S.C. § 112, second paragraph.

The following comments in the Final Action also indicate that the rejections are based on a misunderstanding of the claimed invention:

. . . and the apparent method of contemplated use in the last two lines of article claim 1 seems unnecessary; i.e. does applicant ever envision any embodiments where the product would be sold after its added on adhesive surface was adhered to a building" (Final Action, p. 2).

As an ordinarily skilled artisan reading Applicant's application would understand, the claimed invention involves an adhesive that is *pre-applied* to the fabric layer, i.e., is contacted with the fabric layer before the covering product is adhered to a building structure. This claimed feature distinguishes the claimed invention from a covering product that does not have an adhesive applied to its fabric layer prior to adhering the covering product to a building structure. For example, an adhesive might be spread on a building structure to allow a covering product including a fabric layer to be adhered to the building structure. Also, in the field of commercial roofing, "pre-applied"

typically refers to something being applied during the manufacture of the product as opposed to in the field. For example, U.S. Patent No. 6,080,458 to Russell *et al.*, describes a walkway pad for a roofing membrane wherein an adhesive tape is pre-applied to the lower surface of the pad during manufacture (see U.S. Patent No. 6,080,458 to Russell *et al.*, Col. 3, lines 34-37 and Col. 5, lines 37-40).

For at least the above reasons, the rejection of Claims 1-20 under 35 U.S.C. § 112, second paragraph is *prima facie* improper and should be withdrawn.

D. Failure to Fully Address the Deficiencies of the Non-Final Office Action that were Identified by Applicant and Discussed in Detail in Applicant's December Amendment.

As noted in Sections D and E of Applicant's Amendment After Final, Applicant identified numerous specific deficiencies in the rejection of Claims 1-20 over the combination Venable '785 or '812 in view of WO '866 and discussed these deficiencies in detail in Section E of Applicant's December Amendment. Nevertheless, the Final Action only cursorily addresses the arguments made in Section E of the December Amendment. In fact, the Final Action does not identify as incorrect a single specific detailed argument made by Applicant about the deficiencies of this rejection and these references.

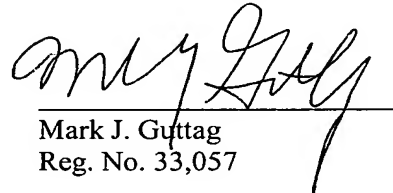
The Final Action also makes additional new arguments that are unsupported by what the cited references teach and suggest. For example, the Final Action's newly alleged "motivation" for combining the references as set forth Section 3 is based merely on what the "Examiner . . . believes" and not what on what the references actually teach or suggest. Furthermore, the Final Action continues to fail to cite actual text in the cited references that teach or suggest the Final Action's alleged motivation for combining the cited references.

Therefore, for at least these reasons, the alleged "motivation" to combine the references set forth in Section 3 of the Final Action is insufficient in view of relevant Federal Circuit precedent such as *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), cited in Applicant's December Amendment, which requires that *specific reasons* must be shown in the art for suggesting a combination of references.

II. Relief Requested.

For at least the reasons discussed above: (1) the Examiner has failed to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant's December 29, 2005 Amendment (Applicant's December Amendment); (2) the Examiner has failed to comply with 37 CFR § 1.104(d)(2) in providing the Affidavit/Declaration requested in Applicant's May 12, 2006 Amendment after Final (Applicant's After Final Amendment); (3) the Final Action has failed to provide an explanation as to why various claims terms do not meet the requirements of 35 U.S.C. § 112; and (4) the Final Action has failed to fully address the deficiencies of the Non-Final Office Action that were identified by Applicant and discussed in detail in Applicant's December Amendment. Therefore, Applicant hereby requests that all of the rejections be withdrawn and Claims 1-20 be allowed.

Respectfully submitted,



Mark J. Gutttag
Reg. No. 33,057

JAGTIANI + GUTTAG
Democracy Square Business Center
10363-A Democracy Lane
Fairfax, Virginia 22030
703-591-2664

June 13, 2006